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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,586	06/17/2005	Kenji Saito	2005_0635A	4361
513 7590 05/07/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
SCRUGGS, ROBERT J				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
05/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,586

Applicant(s)

SAITO ET AL.

Examiner

ROBERT SCRUGGS

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 2, 12, 13, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 10/22/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendments file on January 22, 2008. Claims 1 and 3-11 remain pending in the application and have been fully examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2007 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on October 22, 2007 is noted. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (previously cited) in view of Noguchi et al. (previously cited), Yoneda (cited by applicant) and Miller (2951096). Higuchi et al. and Noguchi et al. as mentioned in the applicant's specification (see specification, pages 3-6) disclose the known

process of surface treating an inner surface of a vacuum member by first mechanically polishing the vacuum member with a liquid medium containing hydrogen atoms, then subjecting the vacuum member to a chemical or electrochemical polishing process. Higuchi et al. and Noguchi et al. also disclose the use of an oxidizing material formed as water which could be added to the liquid medium (see paragraph 6 of Higuchi et al.) however Higuchi et al. and Noguchi et al. lack a liquid medium absent of any hydrogen atoms where said liquid medium being a saturated hydrocarbon in a molecule of which the hydrogen atom or hydrogen atoms are all substituted with a fluorine atom or fluorine atoms. However, Yoneda teaches of providing a non-aqueous solution intermingled with a polishing medium (Paragraph 8), said non-aqueous solution being formed from various types of fluorocarbons (Paragraph 12), since perfluorocarbons are examples of fluorocarbons which have had their hydrogen atoms replaced by fluorine atoms the examiner believes this reference meets this limitation. Also, Miller teaches that perfluorocarbons can be formed from saturated or unsaturated hydrocarbons (Column 1, Line 32) at various temperatures (Column 3, Lines 47-49) and pressures. (Column 4, Lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the liquid medium used in the known process, of Higuchi et al. and Noguchi et al. with a liquid medium formed as a saturated hydrocarbon under ordinary pressure and ordinary temperature wherein the hydrogen atoms are replaced with fluorine atoms, as taught by Yoneda and Miller, in order to provide non-aqueous liquid that is non-flammable and explosion proof thereby more effectively carrying out a polishing process. The examiner would also like to note that claim 1 discloses a vacuum member that is "mechanically polished" but the claim does not include a polishing media

having abrasives. It is a little vague in whether the claim requires abrasive material. Furthermore, is the only step required in this process mechanically polishing? Since, this is a process claim traditional procedures might be considered in a future amendment to more clearly disclose the process (i.e. process having the following steps... (a) step 1... (b) step 2...)

Assuming arguendo, that Miller does not teach a saturated hydrocarbon at a ordinary temperature and pressure, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum are workable ranges involves only routine optimization and experimentation to one of ordinary skill in the art. *In re Aller*, 105 USPQ 233. Here one could select the temperature and pressure to be any level according to the desired characteristics needed by the user to accomplish the intended task.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 3-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT SCRUGGS whose telephone number is (571)272-8682. The examiner can normally be reached on Monday-Thursday, 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RS

/Joseph J. Hail, III/
Supervisory Patent Examiner, Art Unit 3723